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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1161

THE GOODYEAR TIRE & RUBBER COMPANY, *Petitioner*

v.

THE COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

FRANCIS C. BROWNE
Counsel for Petitioner
1815 H Street, N. W.
Washington, D. C. 20006

Of Counsel:

THOMAS D. CAINE
Akron, Ohio

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THE COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Petitioner prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above-entitled case on December 29, 1965 (R. 227).

I. CITATIONS TO OPINIONS BELOW

The opinion of the District Court (R. 216), printed in Appendix A of this petition, is not yet reported in the Federal Reporter System. The opinion of the

Court of Appeals as entered December 29, 1965[1] and as amended *sua sponte* by Order of the Court dated February 28, 1966 (R. 266) appears at R. 267. The opinion, as amended, is printed in Appendix B of this petition. Neither opinion of the Court of Appeals has been reported as yet in the Federal Reporter System.

II. JURISDICTION

The judgment of the Court of Appeals for the District of Columbia Circuit was entered on December 29, 1965 (R. 227). The jurisdiction of this Court is invoked under Title 28, United States Code, Section 1254(1).

III. QUESTION PRESENTED

Is it denial of due process for the Commissioner of Patents to issue a trademark registration without complying with the provisions of the trademark statutes and his own rules of practice?

IV. STATUTES INVOLVED

The statutes involved, printed in Appendix C1 of this petition, are as follows:

Sections 1, 12(a), 12(b), 13 and 41 of the Trademark Act of 1946 (Title 15, United States Code, Sections 1051, 1062(a), 1062(b), 1063 and 1123, respectively).

Section 10, Administrative Procedure Act.

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[1] The opinion of the Court of Appeals filed December 29, 1965 was amended by the Court, *sua sponte*, on February 28, 1966 after denial of a Petition for Rehearing En Banc on February 8, 1966 (R. 265).

V. TRADEMARK RULES OF PRACTICE INVOLVED

The Trademark Rules of Practice involved, printed in Appendix C2 of this petition, are as follows:

Trademark Rules 2.21(c), 2.22, 2.33(a)(iv), 2.33(a)(v), 2.33(b), 2.51(a), (b) and (d), 2.56, 2.61(a), 2.61(b), 2.63, 2.71(a), (b) and (c), 2.81, 2.84(a) and (b), 2.101, 2.104, 2.107, 2.146(a)(3), 2.147, 2.148.

VI. STATEMENT

WEATHER-RITE SPORTSWEAR CO., INC. filed trademark application Serial Number 172,441 in the United States Patent Office on July 3, 1963 seeking registration of "GOODYEAR BY WEATHER-RITE" for "RAINWEAR, NAMELY, COATS, BOOTS, HATS AND WATERPROOF SPORTING GOODS APPAREL" (R. 87-91, inclusive).[2]

The application was referred to an Examiner for action pursuant to Trademark Rules 2.61(a) and (b). Registration was refused by the Examiner on the ground, among others, that the description of applicant's goods did not comply with the requirements of Section 1(a)(1) of the Trademark Act and Trademark Rule 2.33(v) because the wording of the description was "broad and indefinite" (R. 92). Registration was also refused because the drawing did not comply with the requirements of Section 1(a)(2) of the Trademark Act and Trademark Rules 2.33(a) (iv) and 2.51(a), (b) and (d) (ibid).

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[2] Weather-Rite is in no way connected with The Goodyear Tire & Rubber Company. The goods, imported from Japan by Weather-Rite (R. 23-44), are not made by The Goodyear Tire & Rubber Company nor are they made of materials manufactured or supplied by Goodyear.

The applicant amended the description of goods (R. 98) and filed a substitute drawing (R. 117) to overcome the Examiner's rejection. As amended, the goods were described as "RAINWEAR, NAMELY, RAINCOATS, RAINSUITS, RAINHATS, PONCHOS, AND WATERPROOF FISHING SHIRTS, HUNTING SHIRTS, VESTS AND JACKETS, BOOTS, SHOES AND OVERSHOES AND GROUND CLOTHS" (R. 98). The mark shown in the new drawing was "GOODYEAR DE LUXE BY WEATHERRITE" (R. 117). The only specimens on file in the case at that time, however, showed use of the mark only on "baseball shoes" (R. 90).

The Commissioner of Patents caused the mark to be published in the Official Gazette of the Patent Office on May 12, 1964 (R. 8) to enable anyone who felt he might be damaged by the registration of the mark to oppose issuance of a registration thereof, as provided by Section 13 of the Trademark Act and Trademark Rules 2.101 and 2.104. After the 30 day period for opposition had passed, without the filing of an opposition by anybody, but as a consequence of a series of petitions filed by The Goodyear Tire & Rubber Company (petitioner here) [R. 9, 12 and 17], the Commissioner ultimately withdrew the allowance of the application[3] (R. 221) and on October 12, 1964 remanded it to the Examiner for re-examination (R. 146).

The Examiner re-examined the application as provided in Trademark Rule 2.63 and rejected it on Octo-

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[3] If the allowance had not been withdrawn, the mark would have been registered on October 13, 1964 as Registration 778,540. In view of the withdrawal, no registration was issued.

ber 15, 1964 (R. 222), holding that the specimens of the mark which were on file in the application did not show the mark "GOODYEAR DE LUXE BY WEATHERITE" on the goods as described in the application at the time the mark was published in the Official Gazette on May 12, 1964. The only specimens on file at that time showed use of the mark for baseball shoes, whereas baseball shoes were not included in the amended description of goods as of May 12, 1964.

The applicant responded on October 22, 1964 (R. 149-155) by submitting new evidence in the form of additional specimens showing use of the mark on "cold weather boots" (R. 153-155), accompanied by an affidavit of an officer of the company[4] (R. 152) asserting retroactively that the mark shown on the new specimens was in use on the date the application was originally filed, namely, July 3, 1963. *Obviously, this new evidence was not of record when the mark was published on May 12, 1964.* No specimens, whatever, have ever been submitted to show that the mark was used, if ever, on the rest of the goods named in the amended description, namely, "RAINCOATS, RAINSUITS, RAINHATS, PONCHOS, AND WATERPROOF FISHING SHIRTS, HUNTING SHIRTS, VESTS AND JACKETS, SPORT JACKETS, ****, SHOES AND OVERSHOES, AND GROUND CLOTHS".

Petitioner, The Goodyear Tire & Rubber Company, learned from the Patent Office file that the Commissioner was about to issue a registration of "GOOD-

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[4] When the description of goods is amended, Trademark Rule 2.71 requires the filing of additional specimens and a supplemental affidavit by the applicant, just as if it were a newly filed case (Appendix C2, page 16a, *infra*).

YEAR DE LUXE BY WEATHERITE" to the applicant without publishing the mark in the Official Gazette to afford an opportunity for Goodyear or any other person to oppose the issuance of a registration on the basis of the application as it stood after the aforementioned addition of new evidence (R. 78-79). This action was taken by the Commissioner notwithstanding the fact that a request filed by Goodyear on October 9, 1964 (R. 17-69) for reconsideration of the Commissioner's action of October 6, 1964 (R. 15) was pending, but "appears to have been mislaid in the Patent Office" (R. 81).

Since the issuance of a registration was imminent unless prompt action was taken to preserve its rights, petitioner, Goodyear, filed a civil action in the United States District Court for the District of Columbia against the Commissioner of Patents under Section 10 of the Administrative Procedure Act (R. 2-70). A temporary restraining order was issued at 4:00 P.M. on November 23, 1964 directing the Commissioner to withhold registration and maintain the status quo pending the outcome of the civil action[5] (R. 74-75).

The complaint was amended (R. 75), pleading the facts relating to the withdrawal of the application from issue, the re-examination thereof and the threat of the Commissioner to issue the registration without

[5] The temporary restraining order was continued in force by consent of the parties and is still in force pending final disposition of this action. Had this action not been taken, the Commissioner would have issued Registration 780,649 to Weather-Rite at noon on November 24, 1964 (R. 147). In view of the fact that the temporary restraining order is still in force, no registration has issued. Once a registration is issued, petitioner and the public loses forever its right to oppose issuance of the registration under Section 13 of the Trademark Act.

publishing the mark for opposition after the application had been re-examined in the light of the amendment presented in an effort to overcome the fatal deficiency of the applicant. Prayer B sought to compel the Commissioner to publish the mark in accordance with Section 12(a) of the Trademark Act and Trademark Rule 2.81.

Cross-motions for summary judgment (R. 161) and to dismiss (R. 76) were filed by Goodyear and the Commissioner, respectively, there being no dispute as to any genuine issue of material fact and the matter being ripe for consideration *as a matter of law.*

The complaint was dismissed by the District Court after a hearing on the motions (R. 219). A memorandum opinion was filed (R. 216, Appendix A, page 1a, infra).

Appeal was taken to the United States Court of Appeals for the District of Columbia Circuit by Goodyear (R. 219) and the injunction was continued in force pending the appeal (R. 220).

The judgment of the District Court dismissing the complaint was affirmed by the Court of Appeals on December 29, 1965 (R. 227). The opinion filed on the same date was amended, *sua sponte,* by the Court on February 28, 1966 (R. 266, Appendix B, page 4a, infra) even though the Court, *en banc,* denied petitioner's petition for rehearing *en banc* on February 8, 1966 (R. 265).

The present petition is filed, seeking review by writ of certiorari to the Court of Appeals for the District of Columbia Circuit.

VII. REASONS FOR GRANTING THE WRIT

The Commissioner of Patents is charged by Congress with the responsibility for registration of trademarks (35 USC 6). As a part of that responsibility he has a duty to the public to afford it an opportunity to oppose registration of trademarks which do not meet the requirements of the statutes and trademark rules (15 USC 1063). Before affording the public an opportunity to oppose, the Commissioner is charged with the responsibility of examining the application for compliance with the statutes and rules [15 USC 1062(a)]. If, upon "examination or re-examination" it appears that the applicant is entitled to registration, "he shall cause the mark to be published in the Official Gazette of the Patent Office" (Trademark Rule 2.81), whereby the public is afforded an opportunity to oppose the issuance of the registration sought, as provided in 15 USC 1063.

Where, as here, the Commissioner publishes a mark before the requirements of the statutes and rules have been met, and then refuses to publish it again for opposition after those requirements have been met, there is a denial of due process since he is denying the public the right to oppose the issuance of a registration on the facts as they stand in the application after such amendment, i.e., at the time and under the circumstances which would otherwise lead to the issuance of a registration.

The question is one of great public importance which should be decided by this Court since it relates to the administrative process as conducted by all agencies of the Executive Branch and not just to an abuse of the administrative process by the Commissioner of Pat-

ents, whose decisions are accorded a virtually conclusive presumption of correctness[6] by the Courts of the District of Columbia Circuit, but whose decisions are not accorded the same presumption by the Court of Customs and Patent Appeals. The Solicitor for the Patent Office sought to exploit this dichotomy in his argument before the Court in the present case (R 196).

It is significant to note that the refusal of the Commissioner to publish the mark after the amendment was entered is totally inconsistent with the action he took in every case where the issue of second publication was raised heretofore. The Solicitor for the Patent Office admitted that such was the case (R. 191). Illustrations of those cases are set forth in Petitioner's "Petition for Rehearing En Banc" (R 241-242, 246-251).

The present petition should be granted, if for no other reason, at least to resolve once and for all the question of whether the Commissioner of Patents is to be the sole arbiter of the statutes and his own rules or if the Courts are to be the guardians of the public interest by assuring fair, strict, and proper adherence to the administrative process by the Commissioner, as well as the public. The public (for whose benefit the patent and trademark laws are intended) finds itself

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[6] See the recent decisions of the Court of Appeals for the District of Columbia Circuit in *Hays et al.* v. *Brenner*, 148 USPQ 365, footnote 6, 366; *Reynolds* v. *Aghnides*, 148 USPQ 245, 246. It will be noted that there is a direct conflict between those decisions and the following decisions of the Court of Customs and Patent Appeals:

In re Pappas et al., 185 F. 2d 695 (CCPA, 1950)
In re Hummer, 241 F. 2d 742 (CCPA, 1957)
In re Citron, 251 F. 2d 619 (CCPA, 1958)

bogged down in a hopeless morass of legalisitc "buck-passing" as a consequence of the conflict which exists between the Courts of appellate jurisdiction, and should be disentangled by appropriate action of the Supreme Court.

Counsel for petitioner has not found any case decided by this Court on the point involved herein, namely whether the Commissioner may disregard his own rules of practice, as well as the clear and unequivocal terms of the statutes, under the guise of the exercise of administrative discretion. Unless the Judicial Branch insists upon strict adherence by administrative officials to the rules of practice adopted by the Executive Branch and the statutes enacted by the Legislative Branch, the ever-diminishing line of demarcation between the three Branches will become non-existent, the Executive Branch will be a law unto itself, and the Administrative Procedure Act will be a nullity.

The Court of Appeals for the District of Columbia Circuit has made it clear that it does not want to be bothered with cases arising under the Administrative Procedure Act (See *Wembley, Inc.* v. *Commissioner of Patents,* F. 2d ; 147 USPQ 86, where the Court said: "The Administrative Procedure Act, upon which Wembley relies, provides that preliminary, procedural or intermediate agency action or ruling, not directly reviewable, shall be subject to review upon review of the final agency action. * * * * For the Court to move in by mandamus or like remedy to police such rulings of an agency in the course of its proceedings would be

quite contrary to the established norms of judicial review of agency action".)[7]

It is evident that the Courts of the District of Columbia Circuit are surrendering their judicial prerogatives to the Executive Branch and, at the same time, widening the breach between them and the Court of Customs and Patent Appeals. The result is that the public is left to the mercy of that enigmatic (and often fickle) phenomenon normally referred to as "administrative discretion" encountered in the functioning of the administrative machinery of the Executive Branch. Only review by the Supreme Court of the United States and the establishment of a policy of *judicial* enforcement of the administrative process will confine such "discretion" within proper bounds and preclude its use to violate or ignore the express terms of the statutes and rules of practice by the Commissioner of Patents and other administrative bodies and officials. At the same time, it will resolve the diametrically opposed positions of the Courts of the District of Columbia Circuit and the Court of Customs and Patent Appeals, which positions are presently irreconcilable.

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[7] The District Court (235 F. Supp. 704) vacillated in that case, having originally held for plaintiff, but on motion for reconsideration brought by the government, reversed itself and dismissed the complaint, holding that the application of the Patent Office rules was discretionary, citing *Anderson* v. *Watson*, 103 App. D. C., 254 F. 2d 956. In the present case it will be noted that the Court of Appeals also gave the government favored treatment in allowing it to file a brief after the case had been submitted; ignored appellant's indication of a desire to file a reply; denied appellant's petition for rehearing *en banc;* and *then, sua sponte,* amended its opinion without vacating the judgment entered on the opinion previously rendered.

VIII. CONCLUSION

The question for review is presented in the simplest terms possible. Petitioner submits that it, and the public at large, are left without a remedy if the Courts permit administrative officials to circumvent the statutes and their own rules of practice under the guise of exercise of "administrative discretion". This is not the first time it has happened. It will happen again and again unless and until the Supreme Court of the United States makes it clear that there should not be one interpretation of the laws and rules on behalf of the government and another interpretation on behalf of the public. The double standard in the application of "administrative discretion", if discretion rests in the administrative official, should be abolished once and for all.

This is a case in which the Supreme Court of the United States can roll back (or at least restrain) the tide of bureaucracy before it completely engulfs the judiciary as well as the public.

Petitioner respectfully prays, for all of the foregoing reasons, that the present petition be granted.

Respectfully,

FRANCIS C. BROWNE
Counsel for Petitioner
1815 H Street, N. W.
Washington, D. C. 20006

Of Counsel:

THOMAS D. CAINE
Akron, Ohio